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EXAMINER

VU, NGOC K

ART UNIT PAPER NUMBER

2611

DATE MAILED: 10/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/823,218

Applicant(s)

KAY ET AL.

Examiner

Ngoc K. Vu

Art Unit

2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11, 13-18, 20-42, 45-51 and 55-86 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-18, 20-42, 45-51 and 55-86 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Response to Arguments***

1. Applicant's arguments with respect to claims 1-11, 13-18, 20-42, 45-51 and 55-86 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 34-37, 46 and 51 are rejected under 35 U.S.C. 102(e) as being anticipated by Buehl et al. (US 20020129358 A1).

Regarding claim 34, Buehl teaches a method for delivering digital content, the method comprising:

receiving a request for the digital content from a unit (set top box) in a multiple unit environment (multiple subscribers) at a server (115, 195) (see 0035, 0037, 0044, 0047 and figures 3-4);

accessing the digital content from a memory (within the server) (see 0035, 0046);

delivering the digital content to the unit, the delivery of the digital content being independent of an asynchronous delivery of a second digital content to a second unit (e.g., transmitting the requested movie to a particular set top box) in the multiple unit environment (see 0035, 0037, 0044, 0047 and figures 3-4);

accessing a default rate (e.g., regular rate) for the digital content (see 0040, 0039);

accessing a custom rate (e.g., special rate) for the digital content (see 0040, 0049);

Art Unit: 2611

accessing a rate key (e.g., "a class") from a user profile; and  
selecting the default rate or the custom rate for the digital content, based on the rate key  
(the system determines whether the subscriber is eligible to receive discounts. For example, a  
particular subscriber profile may result a better price of the offering, such as where a special  
marketing event occurs for a class that includes the subscriber - see 0041, 0049).

Regarding claim 35, Buehl teaches that delivering the digital content includes enabling  
the unit to access an internetwork (see 0051).

Regarding claim 36, Buehl teaches that delivering the digital content includes delivering  
video to the unit (see 0035, 0042).

Regarding claim 37, Buehl teaches that receiving a request includes receiving a request  
for the digital content from a set top box in the unit (see figures 3-4, 0047).

Regarding claim 46, Buehl teaches applying a discount for the digital content (see 0049,  
0040).

Regarding claim 51, Buehl teaches a computer-readable medium containing a program  
to deliver digital content, the program being executable on a computer system to implement the  
method of claim 34 (see 0030-0032 and interpretation of claim 34 above).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all  
obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 38-42, 45, 47 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable  
over Buehl et al. (US 20020129358 A1) in view of Ellis et al. (US 6,898,762 B2).

Regarding claims 38, 39, 41 and 42, Buehl does not teach delivering the content if the content metadata satisfies a filter, and conditional accessing the digital content according to content metadata and user profile. However, Ellis discloses that server 25 may determine whether a movie or program meets criteria of the user profile to provide to the viewer. For example, movie Armageddon is selected to provide to viewer since it is an action movie and rated as PG-13 according to program information and user profile. The server may use the user profile to filter out undesirable program (see col. 20, lines 26-39; col. 21, lines 16-27). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system Bruehl by including conditional accessing program according to program information and user profile as taught by Ellis in order to provide an appropriate program to viewer.

Regarding claims 40, 45 and 48, Gordon discloses that a particular subscriber profile may result a better price of the offering, such as where a special marketing event occurs for a class that includes the subscriber (see 0041, 0049). Gordon does not disclose storing user profile in a server. Ellis further teaches that user profile is stored in a memory 56 of a server (see col. 6, lines 9-21). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Buehl by storing user profiles in a server as taught by Ellis in order to easily access the profiles at distribution system.

Regarding claim 47, Buehl does not disclose sending a selected advertisement that matches user profile. However, Ellis include that the server may target advertising based on user profile (see Ellis: col. 19, lines 64-65; col. 21, lines 29-34). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Buehl by sending targeted advertisement based on user profile to a particular user in order to effectively provide an appropriate advertisement to the user.

Art Unit: 2611

6. Claims 49 and 67-86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buehl et al. (US 20020129358 A1) in view Gordon et al. (US 20010014975 A1).

Regarding claim 49, Buehl teaches providing movies from service 115 to subscribers (see 0035). Buehl does not teach sending the digital content from a second server to the server for storage. However, Gordon teaches sending viewable objects, i.e., movie, from server 44 to local server 45 for storage data as needed (see 0054-0055). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Buehl by sending data from server 44 to local server 45 for storing data needed as taught by Gordon in order to save space of storage.

Regarding claims 67-86, Buehl does not teach control playing the digital content such as rewind, pause and resume delivery of the digital content from a remote control. However, Gordon teaches the commands for control streaming of the video via the controller 26 to transmission system. The features may include pausing, resuming, fast forwarding, and rewinding the streaming video and/or game (see 0037, 0042, 0045, 0047). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Buehl by for control streaming of the video included pausing, resuming, fast forwarding, and rewinding the streaming video and/or game via the controller 26 to transmission system as taught by Gordon in order to allow the user to control playing video as desired.

7. Claim 50 is rejected under 35 U.S.C. 103(a) as being unpatentable over Buehl et al. (US 20020129358 A1) in view of Hendricks et al. (US 6,539,548 B1).

Regarding claim 50, Buehl teaches accessing a bill for the digital content via billing system (see 0039-0041). Buehl does not displaying the bill in the unit. However, Hendricks shows in figure 37a a detailed billing information of selected movies on screen of TV (see

Art Unit: 2611

figures 37a and col. 44, lines 23-30). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Buehl by displaying the bill on the screen of TV in order to allow the user review the bill in a convenient manner.

8. Claims 1-11, 17, 20, 23, 32 and 55-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gordon et al. (US 20010014975 A1) in view of Buehl et al. (US 20020129358 A1).

Regarding claim 1, Gordon teaches a system (figure 3) for delivering digital content on demand in a multiple unit environment (multiple viewer receivers), the system comprising:

a server (e.g., 45) local to the multiple unit environment, the server including a memory (90) storing the digital content (viewable data objects may be video including movies, games) and content metadata about the digital content stored in the memory of the server (meta data for a video may be a genre, title, actor/director names), and capable of supporting multiple simultaneous asynchronous accesses to the digital content (capable of supporting multiple requests for video from users from different viewer receivers) (see 0028, 0044, 0052, 0054, 0061, 0070 and figures 3 and 4B);

a billing system (39) for billing each individual unit based on use of the digital content, the billing system coupled to the server (see figure 3; 0051, 0034); and

at least one access system (e.g., settop box) in a plurality of units in the multiple unit environment (multiple viewer receivers), the access system designed to access the digital content stored in the memory on the server (see 0033, 0037, 0067, 0042, 0043, 0054, 0055).

Gordon discloses that content metadata includes viewing price (see 0028), but does not explicitly disclose a default rate and a custom rate for the digital content. However, Buehl teach computing price for particular offering/service, e.g., purchasing a movie. The price may be changed based on marketing data associated with an offering/service for providing a regular

Art Unit: 2611

rate or discount/special rate (see 0039, 0040, 0049). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Gordon by including marketing data associated with an offering/service to providing a regular rate or discount/special rate as taught by Buehl in order to effectively computer price for a particular service.

Regarding claim 2, Gordon teaches providing simultaneous asynchronous delivery of the digital content from the memory on the server (45) responsive to requests from multiple access systems in the units (see 0033, 0037, 0049, 0054, 0055).

Regarding claim 3, Gordon teaches providing simultaneous asynchronous delivery includes software designed to read the digital content from the memory on the server and transmit the digital content to the unit (see 0060-0063).

Regarding claims 4 and 5, Gordon teaches controls for pausing the digital content and/or randomly accessing the digital content (0045).

Regarding claim 6, Gordon teaches that the digital content includes content available on an internetwork (e.g., server 43, 44 – see 0054).

Regarding claim 7, Gordon teaches that the digital content includes video (see 0031).

Regarding claim 8, Gordon teaches that the access system includes a set top box (23) designed to enable access to the digital content, the set top box coupled to the server and to a display (24) in the unit (see figures 1-2; 0042).

Regarding claim 9, Gordon teaches that the set top box is coupled to the server via a switching hub for a network, the switching hub designed to allow a plurality of units to access the server (see 0058).

Regarding claim 10, Gordon teaches that the set top box is designed to allow access to a non-digital content (e.g., text) displayed on the display (see 0031, 0033).



Regarding claim 11, Gordon teaches that the set top box includes a handset (26 – see figure 2; 0042).

Regarding claim 17, Gordon discloses that metadata for game includes ratings (see 0028).

Regarding claim 20, Gordon as modified by Buehl further teaches that the price for the offering/service may be changed depending upon subscriber profile. For example, a particular subscriber profile may result a better price of the offering, such as where a special marketing event occurs for a class that includes the subscriber. (see 0049).

Regarding claim 23, Gordon as modified by Buehl further teaches that a discount rate can be applied in addition to the default rate (e.g., a subscriber purchases many movies, the subscriber may become eligible for a special rate for a movie – see 0049).

Regarding claim 32, Gordon further teaches a second sever (44) offsite from the multiple unit environment (see figure 3), the second server coupled to the server (45) to provide digital content to the server (see 0054).

Regarding claims 55-66, Gordon teaches the commands for control streaming of the video via the controller 26 to transmission system. The features may include pausing, resuming, fast forwarding, and rewinding the streaming video and/or game (see 0037, 0042, 0045, 0047).

9. Claims 13-16, 18, 21, 22, 24-31 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gordon et al. (US 20010014975 A1) in view of Buehl et al. (US 20020129358 A1) and further in view of Ellis et al. (US 6,898,762 B2).

Regarding claim 13, 14, 16, 29 and 30, Gordon as modified by Buehl further teaches the system using subscriber profile for determining a special rate for purchase a service (see Buehl: 0049). Both fail to teach conditional accessing the digital content according to content metadata and user profile. However, Ellis discloses that server 25 may determine whether a movie or

Art Unit: 2611

program meets criteria of the user profile to provide to the viewer. For example, movie Armageddon is selected to provide to viewer since it is an action movie and rated as PG-13 according to program information and user profile. The server may use the user profile to filter out undesirable program (see col. 20, lines 26-39; col. 21, lines 16-27). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined system of Gordon and Bruehl by including conditional accessing program according to program information and user profile as taught by Ellis in order to provide an appropriate program to viewer.

Regarding claims 15, 18, 21, 22, 25, 26, 31 and 33, Gordon and Bruehl as modified by Ellis further discloses that the user profile is stored in a memory 56 of a server (see Ellis: col. 6, lines 9-21).

Regarding claims 24, 27 and 28, the combined teachings of Gordon and Bruehl and Ellis include that the server may target advertising based on user profile (see Gordon: 0067; Ellis: col. 19, lines 64-65; col. 21, lines 29-34).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ngoc K. Vu whose telephone number is 571-272-7306. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on 571-272-7294. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2611

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Ngoc K. Vu', with a long horizontal flourish extending to the right.

Ngoc K. Vu  
Primary Examiner  
Art Unit 2611

September 30, 2005